REMARKS

Applicant has carefully reviewed the Office Action mailed July 31, 2007 and offers the following remarks. Applicant concurrently files a Declaration of the inventor, Dany Sylvain, and a Declaration of Benjamin S. Withrow, Assignee's outside patent attorney who drafted the present application, under 37 C.F.R. § 1.131.

Applicant wishes to thank the Examiner for indicating that claims 4-11, 17, 22-29, and 35 would be allowable if rewritten in independent form. Applicant reserves the right to rewrite claims 4-11, 17, 22-29, and 35 at a later time.

Claims 1, 2, 4, 11, 12, and 17 were objected to for containing "adapted to" language. The Examiner has objected to the term "adapted to" as not being a positive limitation. However, in the present case, the term "adapted to" is a positive limitation. The Patent Office's assertion that the "adapted to" language is improper is not supported by the applicable case law. Contrary to the Patent Office's assertion, the Federal Circuit has mandated that "adapted to" language is a positive limitation and must be considered when weighing patentability. *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990) (citing *In re Venezia*, 530 F.2d 956 (CCPA 1976)). Moreover, functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation in the claim, for what it fairly conveys to a person of ordinary skill in the art. MPEP § 2173.05(g). A functional limitation is often used in association with an element or step of a process or method to define a particular capability or purpose that is served by the recited element or step. *Ibid.* The determination of whether an "adapted to" clause is a limitation in a claim depends on the specific facts of the case. MPEP § 2111.04. When such a clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention. *Ibid.*; see *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 U.S.P.Q.2d (BNA) 1481, 1483 (Fed. Cir. 2005).

In the present invention, the term "adapted to" sets definite boundaries on the scope of the patent protection. As an example, claim 1 recites at least one communication interface providing network connectivity to at least one communication network, and a control system associated with the at least one communication interface, the control system adapted to carry out the claimed steps. The "adapted to" clause clearly sets forth steps that are material to patentability; if ignored, it would change the substance of the invention. *See Hoffer v. Microsoft*

Corp., 405 F.3d at 1329, 74 U.S.P.Q.2d (BNA) at 1483 (Fed. Cir. 2005). Therefore, the "adapted to" clause must be considered. As the objected to claim language is allowed by the Federal Circuit case law, Applicant respectfully requests the rejection be withdrawn, and claims 1-36 be allowed.

Claims 1, 18, 19, and 36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,999,770 B2 to Hirsbrunner et al. (hereinafter "Hirsbrunner"). Applicant respectfully traverses.

For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. The requirement that each and every element be disclosed in the manner claimed is a rigorous standard that the Patent Office has not met in this case.

35 U.S.C. § 102(e) requires that the invention be "...described in (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent**" (emphasis added). However, Applicant conceived of the present invention prior to the filing date of Hirsbrunner, and constructively reduced the present invention to practice through the filing of the present application. As such, Hirsbrunner does not qualify as prior art under § 102(e).

In order to establish that Hirsbrunner does not qualify as prior art under § 102(e), Applicant herein presents the Declaration of the inventor, Dany Sylvain, under 37 C.F.R. § 1.131, illustrating conception of the present invention prior to the filing date of Hirsbrunner. Applicant also presents the Declaration of Applicant's representative, Benjamin S. Withrow, the patent attorney who drafted the present application, to be used in conjunction with the Declaration of the inventor, Dany Sylvain. These declarations show diligence from a time prior to the filing date of the Hirsbrunner reference through a constructive reduction to practice of the present invention by the filing of the present application.

Based on the Declarations, Applicant asserts that the present invention was conceived of at least as early as December 5, 2003. Inventor Dany Sylvain conceived of the Present Invention at least as early as December 5, 2003, the date when Mr. Sylvain completed the Invention Disclosure and submitted it to the Intellectual Property Law Department at Nortel (See Declaration of Dany Sylvain, Paragraphs 3-5, and Appendix A). Appendix A to the Declaration

of Dany Sylvain (hereinafter "Invention Disclosure") clearly shows conception of each of the limitations of the present invention, as seen below with respect to representative claim 19[1]:

A method comprising:

a) determining network connectivity (see Invention Disclosure, p. 2, Brief Description of Invention and Problem Solved by the Invention; see also Figure, p. 4, and Rough Claims, p. 5);

b) determining a terminating address for a terminating party based on the network connectivity to at least one communication network (see Invention Disclosure, p. 2, Brief Description of Invention and Problem Solved by the Invention; see also Figure, p. 4, and Rough Claims, p. 5); and

c) initiating communications with the terminating party using the terminating address (see Invention Disclosure, p. 2, Brief Description of Invention and Problem Solved by the Invention; see also Figure, p. 4, and Rough Claims, p. 5).

Thus, as seen above, at least as early as December 5, 2003, before the December 30, 2003 filing date of Hirsbrunner, Mr. Sylvain had conceived of the invention claimed in the present application.

Further, the declarations show that from a date prior to December 30, 2003 (the filing date of Hirsbrunner), diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on April 14, 2004. (See Declaration of Benjamin S. Withrow, Paragraphs 3-14; and Declaration of Dany Sylvain, Paragraphs 5-12). In particular, prior to December 30, 2003, in-house patent attorney for the assignee of the present application reviewed the Invention Disclosure and approved it for discussion at the next scheduled Patent Review Committee meeting (See Declaration of Dany Sylvain, Paragraph 5). On January 9, 2004, at the next scheduled Patent Review Committee after the Invention Disclosure was received, the Patent Review Committee of the assignee of the present application reviewed the Invention Disclosure, made comments, and passed the Invention Disclosure back to the in-house patent attorney for the assignee. *Ibid.* Between January 9, 2004, and January 20, 2004, the in-house patent attorney reviewed the Invention

[1] Independent claim 1 is directed to a terminal, but has basically the same limitations as claim 19, and therefore was also conceived of at least as early as December 5, 2003, as shown in the Invention Disclosure.

Disclosure and the comments from the Patent Review Committee, and made a final decision to file a patent application seeking protection for the invention disclosed in the Invention Disclosure. *Ibid.* The in-house patent attorney for the assignee sent instructions on January 20, 2004 to Benjamin S. Withrow, registered U.S. patent attorney, Registration No. 40,876, of the law firm of Withrow & Terranova, PLLC, instructing him to prepare and file a patent application for the Invention Disclosure (see Declaration of Benjamin S. Withrow, Paragraph 3, and Appendix A; see also Declaration of Dany Sylvain, Paragraph 6 and Appendix B). Mr. Withrow also received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures prior to January 20, 2004 (see Declaration of Benjamin S. Withrow, Paragraph 5). From the time of receiving the instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures, until about April 14, 2004, Mr. Withrow worked to prepare patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion (see Declaration of Benjamin S. Withrow, Paragraph 6).

Starting from January 20, 2004, and continuing through April 14, 2004, Mr. Withrow diligently reviewed the Invention Disclosure, spoke with the inventor Dany Sylvain, and diligently worked to prepare a patent application claiming the invention disclosed in the Invention Disclosure (see Declaration of Benjamin S. Withrow, Paragraph 7; see also Declaration of Dany Sylvain, Paragraph 7). The diligent work by Mr. Withrow resulted in a first draft of the Patent Application, which was sent to the inventor on February 26, 2004 (see Declaration of Benjamin S. Withrow, Paragraph 8 and Appendix B; see also Declaration of Dany Sylvain, Paragraph 8 and Appendix C). The inventor, Mr. Sylvain, then reviewed the draft application and provided minor comments regarding the First Draft to Mr. Withrow on March 12, 2004 (see Declaration of Benjamin S. Withrow, Paragraph 9 and Appendix C; see also Declaration of Dany Sylvain, Paragraph 9). On March 15, 2004, Mr. Withrow revised the Patent Application to incorporate the comments from the inventor and sent a revised Patent Application to in-house counsel at Nortel Networks Limited, the assignee (see Declaration of Benjamin S. Withrow, Paragraph 10 and Appendix C). A copy of the revised Patent Application, the inventor declaration, and the assignment document was also sent on March 15, 2004 to the inventor for his signature (see Declaration of Benjamin S. Withrow, Paragraph 11 and Appendix C; see also Declaration of Dany Sylvain, Paragraph 10). On April 14, 2004, after having received a signed

inventor declaration and assignment document from the inventor, and approval from in-house counsel at Nortel Networks Limited to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on March 15, 2004, the Patent Application was filed with the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/824,226 (See Declaration of Benjamin S. Withrow, Paragraphs 12-14 and Appendix C; Declaration of Dany Sylvain, Paragraphs 11-12). Thus, from a date prior to December 30, 2003, the filing date of Hirsbrunner, diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on April 14, 2004.

The filing date of the Hirsbrunner reference is December 30, 2003. Based on the declarations and the above facts, Applicant respectfully submits that the date of invention for the present application was prior to Decmber 30, 2003 and that diligent action was taken from a time period prior to December 30, 2003, through the filing of the present application to constructively reduce the invention to practice. Therefore, Hirsbrunner was not filed before Applicant's present invention. Thus, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1, 18, 19, and 36 as being anticipated by Hirsbrunner is improper and should be withdrawn. Applicant reserves the right to address Hirsbrunner in the future if required.

Claims 2, 3, 12-16, 20-24, and 30-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirsbrunner in view of U.S. Patent No. 7,099,306 B2 to Goodman et al. (hereinafter "Goodman"). Applicant respectfully traverses.

As set forth above, Hirsbrunner is not prior art under § 102(e) because Applicant conceived of the present invention prior to the filing date of Hirsbrunner, and constructively reduced the present invention to practice through the filing of the present application. Since Hirsbrunner is not available as prior art, the rejection of claims 2, 3, 12-16, 20-24, and 30-34 over Hirsbrunner and Goodman is improper and must be withdrawn.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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